

**BOARD OF PATENT APPEALS AND INTERFERENCES
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicants : Stuart A. Fraser, et al.
Application No. : 09/670,900 Confirmation No. : 7800
Filed : September 28, 2000
For : SYSTEMS AND METHODS FOR TRANSFERRING
ITEMS WITH RESTRICTED TRANSFERABILITY
Group Art Unit : 3625
Examiner : James H. Zurita

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

Sir:

This is an appeal from the decision of Examiner James H. Zurita, Group Art Unit 3625, in the non-final Office Action of June 19, 2006, rejecting claims **1, 3-4, 6-17, 20-37, 41-56, 60-77, 81-98, 102-119, and 123-135** in the present application. A Notice of Appeal was filed on September 19, 2006.

This paper includes items (i) through (x) as required under 37 C.F.R. § 41.37(c)(1) and M.P.E.P. § 1205.

The Commissioner is hereby authorized to charge the Appeal Brief filing fee as set forth in 37 C.F.R. § 41.20(b)(2) of \$500.00, as well as any additional fees which may be required, or credit any overpayment, to Deposit Account No. 50-3938.

TABLE OF CONTENTS

I.	<u>REAL PARTY IN INTEREST</u>	3
II.	<u>RELATED APPEALS AND INTERFERENCES</u>	4
III.	<u>STATUS OF THE CLAIMS</u>	5
IV.	<u>STATUS OF AMENDMENTS</u>	6
V.	<u>SUMMARY OF CLAIMED SUBJECT MATTER</u>	7
VI.	<u>GROUND S OF REJECTION TO BE REVIEWED ON APPEAL</u>	9
VII.	<u>SUMMARY OF ARGUMENTS</u>	10
VIII.	<u>ARGUMENTS</u>	12
	1. Legal Standard – Prima Facie Showing	12
	2. Legal Standard – Obviousness	12
	3. First Group: Claims 1, 3-4, 6-16, 20-22, 29-37, 41, 48-52, 116-119, and 123-131 – No Prima Facie Showing of Obviousness	13
	4. Second Group: Claims 4, 34-37, 41, and 48-52 – No Prima Facie Showing of Obviousness	14
	5. Third Group: Claims 1, 3-4, 6-16, 20-22, 29-37, 41, 48-56, 60-62, 69-77, 81-83, 90-98, 102-104, 111-119, and 123-134 – No Prima Facie Showing of Obviousness	15
	a. Issue 1 – The Examiner has failed to provide substantial evidence to support an asserted suggestion or motivation to modify <u>Gebh</u>	15
	b. Issue 2 – The Examiner has continuously failed to provide any evidence of record to support the asserted suggestion or motivation to modify <u>Gebh</u>	16
	6. Fourth Group - Claim 31-33, 50-52, 71-73, 92-94, and 113-115 - No Prima Facie Showing of Obviousness	17
	7. Fifth Group: Claim 33, 52, 73, 94, and 115 - No Prima Facie Showing of Obviousness	19
	8. Sixth Group: Claims 12, 15, 36, 55, 76, 97, and 118 - No Prima Facie Showing of Obviousness	20
	9. Seventh Group: Claims 12, 16, 37, 56, 77, 98, and 119 - No Prima Facie Showing of Obviousness	21
IX.	<u>CONCLUSION</u>	23
X.	<u>CLAIMS APPENDIX</u>	24
XI.	<u>EVIDENCE APPENDIX</u>	43
XII.	<u>RELATED PROCEEDINGS APPENDIX</u>	44

I. REAL PARTY IN INTEREST

The real party in interest of the present application is CFPH, the assignee of record, a limited liability company organized and existing under the laws of the State of Delaware, U.S.A., and having a place of business at 110 East 59th Street, New York, NY 10022.

II. RELATED APPEALS AND INTERFERENCES

There are no known related appeals or interferences.

III. STATUS OF THE CLAIMS

The following claims are pending and stand rejected in the present application:

- Independent claims **1, 13, 34, 53, 74, 95, and 116.**
- Dependent claims **3-4, 6-12, 14-16, 20-22, 29-33, 35-37, 41, 48-52, 54-56, 60-62, 69-73, 75-77, 81-83, 90-94, 96-98, 102-104, 111-115, 117-119, and 123-134.**

The following claims have been cancelled:

- Dependent claims **2, 5, 17-19, 23-28, 38-40, 42-47, 57-59, 63-68, 78-80, 84-89, 99-101, 105-110, 120-122, and 135.**

The following claims are being appealed:

- Independent claims **1, 13, 34, 53, 74, 95, and 116.**
- Dependent claims **3-4, 6-12, 14-16, 20-22, 29-33, 35-37, 41, 48-52, 54-56, 60-62, 69-73, 75-77, 81-83, 90-94, 96-98, 102-104, 111-115, 117-119, and 123-134.**

IV. STATUS OF AMENDMENTS

An Amendment was filed on February 16, 2007 under 37 C.F.R. § 41.33(a) to cancel several claims and to amend several claims in order to present the claims in better form for consideration on appeal. Specifically, the following claims were amended:

- Independent claim **116**.
- Dependent claims **20, 41, 60, 81, 102, 117, 126-127, and 130-134**.

The following claims were cancelled:

- Dependent claims **17, 23-28, 42-47, 63-68, 84-89, 105-110, and 135**.

Appellants have not received indication as to whether the Amendment has been acted upon by the Examiner or whether the Amendment has been entered. Item III, Status of the Claims, and Item X, Claims Appendix, reflect the claim cancellations and amendments made in the Amendment.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The present claims are directed to a method (and electronic trading arrangement) that enables a first consumer to transfer an item to a second consumer. [Specification, page 2, lines 29-32]. According to an embodiment of the invention, a request is received from the first consumer to transfer the item. [Specification, page 5, lines 11-14; page 6, lines 31-33; Figure 1, step 8; Figure 2, step 23]. A plurality of options are also presented to the first consumer, wherein the options include a transfer by auction selection and a transfer by posting an advertisement selection, wherein posting an advertisement includes posting a price. [Specification, page 5, lines 15-25; page 6, line 33 to page 7, line 1; Figure 2, step 23]. Authorization to transfer the item is requested from a provider of the item. [Specification, page 5, lines 26-27; page 7, lines 1-4; Figure 1, step 9; Figure 2, step 24]. Restrictions on the transfer of the item may be received from the provider of the item and these restrictions implemented with respect to the item. [Specification, page 6, lines 8-12; page 7, lines 17-26; Figure 2, step 26]. Information about the item is subsequently presented to the second consumer in response to a selection by the first consumer of one of the options. [Specification, page 7, line 31 to page 8, line 2; Figure 1, step 12]. Thereafter, an offer to purchase the item is received from the second consumer and the item is transferred from the first consumer to the second consumer in response to receiving the offer to purchase. [Specification, page 8, lines 2-25; Figure 1, steps 13-19].

According to another embodiment of the invention, a request is received from the first consumer to sell the item. [Specification, page 5, lines 11-14; page 6, lines 31-33; Figure 1, step 8; Figure 2, step 23]. A plurality of options are also presented to the first consumer, wherein the options include a transfer by auction selection and a transfer by posting an advertisement selection, wherein posting an advertisement includes posting a price. [Specification, page 5, lines 15-25; page 6, line 33 to page 7, line 1; Figure 2, step 23]. A provider of the item is contacted with respect to the transfer of the item. [Specification, page 5, lines 26-27; page 7, lines 1-4; Figure 1, step 9; Figure 2, step 24]. Restrictions on the transfer of the item are received from the provider of the item and these restrictions implemented with respect to the item. [Specification, page 6, lines 8-12; page 7, lines 17-26; Figure 2, step 26]. Information about the item is subsequently presented to the second consumer in response to a selection by the first consumer of one of the options. [Specification, page 7, line 31 to page 8, line 2; Figure 1, step 12]. Thereafter, an offer to purchase the item is received from the second consumer and the

transfer of the item is arranged from the first consumer to the second consumer in response to receiving the offer to purchase. [Specification, page 8, lines 2-25; Figure 1, steps 13-19].

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The grounds for rejection to be reviewed on appeal are whether independent claims **1, 13, 34, 53, 74, 95, and 116** and dependent claims **3-4, 6-12, 14-16, 20-22, 29-33, 35-37, 41, 48-52, 54-56, 60-62, 69-73, 75-77, 81-83, 90-94, 96-98, 102-104, 111-115, 117-119, and 123-134** are obvious in view of Gebb U.S. Patent No. 6,067,532 (hereinafter Gebb).

VII. SUMMARY OF ARGUMENTS

1. The Examiner has failed to establish a *prima facie* case of obviousness with respect to any of the appealed claims. Specifically:
 - a. The Examiner has failed to show that Gebb teaches, suggests, or discloses the following features of the appealed claims:
 - Claims of the First Group: *“requesting authorization to transfer the item from a provider of the item”*
 - Claims of the Second Group: *“requesting authorization to transfer the item from a provider of the item; [and] notifying the first consumer whether the provider authorized or denied the transfer”*
 - Claims of the Third Group: *“presenting to the first consumer a plurality of options, wherein the options include a transfer by auction selection and a transfer by posting an advertisement selection, wherein posting an advertisement comprises posting a price”*
 - Claims of the Fourth Group: *“providing for the provider to receive a fee from the payment from the second consumer”*
 - Claims of the Fifth Group: *“providing for the provider to receive a fee from the payment from the second consumer; ... wherein the fee is a percentage of the payment”*
 - Claims of the Sixth Group: *“receiving restrictions on the transfer of the item from the provider of the item; ... wherein receiving restrictions on the transfer of the item comprises setting a minimum price for the item”*
 - Claims of the Seventh Group: *“receiving restrictions on the transfer of the item from the provider of the item; ... wherein receiving restrictions on the transfer of the item comprises setting a maximum number of items that may be sold”*
 - b. The Examiner has failed to provide evidence of record to support an asserted suggestion or motivation to modify Gebb to perform the following feature of the appealed claims:
 - Claims of the Third Group: *“presenting to the first consumer a plurality of options, wherein the options include a transfer by auction selection and a transfer by posting an advertisement selection, wherein posting an advertisement comprises posting a price”*

2. Gebb does not teach, suggest, nor disclose the above noted features of the appealed claims.

VIII. ARGUMENTS

Rejection Under 35 U.S.C. § 103(a) over Gebb U.S. Patent No. 6,067,532

All appealed claims were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gebb. Fourth Office Action, pages 3-6.

1. Legal Standard – Prima Facie Showing.

If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent. In re Oetiker, 977 F.2d 1443, 1445 (Fed. Cir. 1992). The initial burden of presenting a *prima facie* case of obviousness is upon the examiner. In re Oetiker, 977 F.2d at 1445. If the examiner fails to establish a *prima facie* case of obviousness, the rejection is improper and will be overturned. In re Rijckaert, 9 F.3d 1531, 1532 (Fed. Cir. 1993); Novamedix Distrib. Ltd. v. Dickinson, 175 F. Supp. 2d 8, 9 (D.D.C. 2001).

2. Legal Standard – Obviousness.

To reject claims under 35 U.S.C. § 103, an examiner must show an un rebutted *prima facie* case of obviousness. In re Rouffet, 149 F.3d 1350, 1355 (Fed. Cir. 1998). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981 (CCPA 1974).

In addition, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference. The Examiner must support with substantial evidence of record a factual finding of a suggestion or motivation to modify a reference. Novamedix Distrib., 175 F. Supp. 2d at 9; In re Zurko, 258 F.3d 1379, 1383-1386 (Fed. Cir. 2001); In re Lee, 277 F.3d 1338, 1342 (Fed. Cir. 2002). In particular, a conclusory or common sense statement as to the factual question of motivation must be supported by evidence of record and without such evidence, lacks substantial evidence support and is thereby insufficient to establish a *prima facie* case of obviousness. In re Lee, 277 F.3d at 1343-1345 (“[C]onclusory statements ... do not adequately address the issue of motivation to combine. ... [The] factual question of motivation is material to patentability, and [can] not be resolved on subjective belief and unknown authority.”); In re Zurko, 258 F.3d at

1385 (“This assessment of basic knowledge and common sense was not based on any evidence in the record and, therefore, lacks substantial evidence support.”).

3. First Group: Claims 1, 3-4, 6-16, 20-22, 29-37, 41, 48-52, 116-119, and 123-131 – No Prima Facie Showing of Obviousness.

The First Group is a subset of the Third Group and is therefore patentable for the reasons set forth below for the Third Group. In addition, the following separate arguments of patentability apply.

Independent claim 1 is representative of the group and recites the following features:

*receiving a request to transfer the item from the first consumer; [and] ...
requesting authorization to transfer the item from a provider of the item.*

Gebb does not teach, suggest, nor disclose “*requesting authorization to transfer the item from a provider of the item*” and as such, the Examiner has failed to establish a *prima facie* case of obviousness with respect to the claims of the First Group. In particular, Gebb has no need for this feature.

Specifically, in rejecting claim 1, the Examiner asserted that the “seller” of Gebb is the “*first consumer*” of claim 1 and that the “particular arena, promoter or entity” of Gebb is the “*provider*” of claim 1. Fourth Office Action, page 4. The Examiner further asserted without support that Gebb discloses at column 6, line 15 “requesting authorization to transfer the item.” Id. This portion of Gebb does not teach, suggest, nor disclose the above feature of claim 1.

Specifically, at column 6, lines 15-20 Gebb discloses a system that “sends a data packet to the seller’s computer screen requesting that the seller approve [a] consignment agreement with [a] host organization.” As indicated, the “seller” of Gebb, as asserted by the Examiner, is similar to the “*first consumer*” of claim 1 and no where does Gebb appear to teach, suggest, or disclose that the “host organization” is a “particular arena, promoter or entity” (i.e., “*provider*,” as asserted by the Examiner). As such, this portion of Gebb does not disclose any form of a consignment agreement with a “*provider*.” Accordingly, contrary to claim 1, this portion of Gebb does not teach, suggest, nor disclose “*requesting authorization to transfer the item from a provider of the item.*”

The Examiner further asserted without support that Gebb discloses at column 7, line 53 “a provider authorizing the transfer.” Fourth Office Action, page 4. This portion of Gebb also

does not teach, suggest, nor disclose the above feature of claim 1. Specifically, at column 7, line 53 to column 8, line 2 Gebb discloses that the system “analyzes any agreements with the particular arena, promoter or entity regarding the establishment of [a] resale price.” “[I]f an agreement with a particular arena prevents” “the resale of tickets” “at a higher price” “than the face value of the ticket”, “the system will only add a transaction fee which conforms to any transaction fee limitation ... within an arena agreement” and “[i]f the ... arena does not restrict the resale of tickets at an increased price, ... buyers [are allowed] to ‘bid’ for the ticket such that the ticket will be sold to the highest bidder.” In establishing a resale price as disclosed by Gebb, Gebb discloses a system that assumes “*requesting authorization to transfer the item from a provider of the item*” is not required and never makes this “*request[]*” “*from a provider.*” As such, this portion of Gebb also does not teach, suggest, nor disclose “*requesting authorization to transfer the item from a provider of the item,*” as recited by claim 1.

In addition, Gebb in general does not teach, suggest, nor disclose the “*requesting authorization*” feature of claim 1.

Because the Examiner has failed to show that all the limitations of independent claim 1, and similarly independent claims 13, 34, and 116, are taught or suggested by Gebb, the Examiner has failed to establish a *prima facie* case of obviousness with respect to these claims, and the claims that depend there from. The rejection of these claims is thereby improper.

4. Second Group: Claims 4, 34-37, 41, and 48-52 – No Prima Facie Showing of Obviousness.

SEPARATE ARGUMENT OF PATENTABILITY.

The Second Group is a subset of the First Group and is therefore patentable for the reasons set forth above for the First Group. The Second Group is also a subset of the Third Group and is therefore also patentable for the reasons set forth below for the Third Group. In addition, the following separate arguments of patentability apply.

Dependent claim 4 is representative of the group and recites, together with independent claim 1, the following features:

*requesting authorization to transfer the item from a provider of the item; [and]
notifying the first consumer whether the provider authorized or denied the
transfer.*

The Examiner has failed to indicate where Gebb discloses “*the provider authorized or denied the transfer.*” In addition, Gebb does not teach, suggest, nor disclose “*the provider authorized or denied the transfer.*” As such, the Examiner has failed to establish a *prima facie* case of obviousness with respect to the claims of the Second Group.

Specifically, the Examiner does not appear to indicate anywhere in the Fourth Office Action where Gebb teaches, suggests, or discloses that the “particular arena, promoter or entity” of Gebb (i.e., “*provider,*” as asserted by the Examiner) “*authorize[s] or denie[s] the transfer*” and as such, the Examiner has failed the initial burden of presenting a *prima facie* case of obviousness with respect to claim 4. The rejection is thereby improper.

In addition, as indicated Gebb does not teach, suggest, nor disclose “*requesting authorization to transfer the item from a provider of the item*” and as such, cannot teach, suggest, nor disclose that “*the provider authorized or denied the transfer,*” as recited by claim 4.

Because the Examiner has failed to show that all the limitations of dependent claim 4, and similarly independent claim 34 and the claims that depend there from, are taught or suggested by Gebb, the Examiner has failed to establish a *prima facie* case of obviousness with respect to these claims. The rejection is thereby improper.

5. Third Group: Claims 1, 3-4, 6-16, 20-22, 29-37, 41, 48-56, 60-62, 69-77, 81-83, 90-98, 102-104, 111-119, and 123-134 – No Prima Facie Showing of Obviousness.

SEPARATE ARGUMENT OF PATENTABILITY.

a. Issue 1 – The Examiner has failed to provide substantial evidence to support an asserted suggestion or motivation to modify Gebb.

Independent claim 1 is representative of the group and recites the following feature:

presenting to the first consumer a plurality of options, wherein the options include a transfer by auction selection and a transfer by posting an advertisement selection, wherein posting an advertisement comprises posting a price.

In rejecting claim 1, the Examiner asserted that “Gebb does not explicitly disclose” the above feature of claim 1. Fourth Office Action, page 6.

In further rejecting claim 1, the Examiner merely asserted conclusory statements as to the suggestion or motivation to modify Gebb to perform this feature but presented no evidence of

record to support these conclusory statements. As such, there can be no *prima facie* case of obviousness.

Specifically, in rejecting claim 1 regarding the feature of “*presenting to the first consumer a plurality of options ...*,” the Examiner asserted, in part, that Gebb discloses an “advertising interface” and a “bidding interface,” that “a web page with selectable options” is well known, and that

[o]ne of ordinary skill in the art at the time the invention was made would have been motivated to extend Gebb’s web pages to ... includ[e] a web page with selectable options for the obvious reason that by doing so, the system can restrict a user’s options and possibly reduce input errors [and] [f]urther, the selection would allow the seller to choose a preferred method of sale, i.e., auction or set-price, in order to give the seller the most flexibility, thereby enhancing customer satisfaction.

Fourth Office Action, pages 5-6.

There is no evidence that the Examiner’s purported “benefits” (i.e., to “restrict a user’s options and possibly reduce input errors” and “to give the seller the most flexibility, thereby enhancing customer satisfaction”), even if they were true, would have prompted one of ordinary skill in the art to modify Gebb to perform the recited feature of claim 1.

Further, the Examiner merely asserted conclusory statements (i.e., purported “benefits”) as to the suggestion or motivation to modify Gebb to “includ[e] a web page with selectable options” and to “allow the seller to choose a preferred method of sale, i.e., auction or set-price,” but presented no evidence of record to support these conclusory statements. Without any evidence to support a suggestion or motivation to modify a reference, there can be no *prima facie* case of obviousness. Accordingly, the rejection of independent claim 1, and similarly independent claims 13, 34, 53, 74, 95, and 116, and the claims that depend there from, is improper.

b. Issue 2 – The Examiner has continuously failed to provide any evidence of record to support the asserted suggestion or motivation to modify Gebb.

Regarding the Examiner’s conclusory statement (i.e., “to give the seller the most flexibility, thereby enhancing customer satisfaction”) as to the suggestion or motivation to modify Gebb to “allow the seller to choose a preferred method of sale, i.e., auction or set-price,”

Appellants have repeatably traversed this obviousness rejection and specifically disputed the lack of evidence to support the Examiner's asserted suggestion or motivation. Nevertheless, the Examiner has not provided any evidence to support the rejection.

Specifically, in the Second Office action the Examiner first made the conclusory statement that it would be obvious to modify Gebb "in order to give the seller the most flexibility, thereby enhancing customer satisfaction." Second Office Action, page 6. In response to the Examiner's assertion, Appellants' stated that the Examiner failed to provide "prior art motivation to modify Gebb to include all the features of applicants' claimed invention," thereby indicating to the Examiner that the Examiner must support with substantial evidence of record a factual finding as to the suggestion or motivation to modify a reference. Appellants' Second Response, pages 48-50. In the Third Office Action the Examiner again made the above conclusory statement and further asserted that the statement is now admitted prior art. Third Office Action, pages 9-10 and 13. In response, Appellants' again stated that "there is no substantial evidence to support the Examiner's official notice assertion without documentary evidence, and therefore there has been no prima facie showing of obviousness." Appellants' Third Response, page 33. Nonetheless, in the Fourth Office Action the Examiner again made the above conclusory statement and again asserted that the statement is now admitted prior art. Fourth Office Action, pages 6-9.

Accordingly, Appellants have repeatably traversed the Examiner's obviousness rejection and have repeatably requested the Examiner provide evidence of record to support the Examiner's asserted suggestion or motivation to modify Gebb. Again, the Examiner has not provided any evidence to support the rejection.

6. Fourth Group - Claim 31-33, 50-52, 71-73, 92-94, and 113-115 - No Prima Facie Showing of Obviousness.

SEPARATE ARGUMENT OF PATENTABILITY.

The Fourth Group is a subset of the Third Group and is therefore patentable for the reasons set forth above for the Third Group. In addition, the following separate arguments of patentability apply.

Dependent claim **31** is representative of the group and recites the following feature:

providing for the provider to receive a fee from the payment from the second consumer.

Gebb does not teach, suggest, nor disclose “*providing for the provider to receive a fee from the payment from the second consumer*” and as such, the Examiner has failed to establish a *prima facie* case of obviousness with respect to the claims of the Fourth Group.

In particular, in rejecting claim **31**, the Examiner asserted without support that Gebb discloses at column 9, line 16 “the provider receives a fee from the payment of the second consumer.” Fourth Office Action, page 6. This portion of Gebb does not teach, suggest, nor disclose the above feature of claim **31**.

Specifically, at column 9, lines 14-21 Gebb discloses that a seller is “credited a predetermined amount, such as, for example, the face value of the ticket less a transaction fee.... Alternatively, seller receives payment for the sale of the ticket, which may be more or less than the face value, based on the results of the buyer bidding process, agreements with the arenas, promoters, etc.” This portion of Gebb does not teach, suggest, nor disclose “*providing for*” the “particular arena, promoter or entity” (i.e., “*provider*,” as asserted by the Examiner) “*to receive [the transaction] fee*,” as claim **31** recites.

In addition, with respect to the “agreements with the arenas, promoters, etc.,” as disclosed by Gebb at column 9, lines 14-21, Gebb does not teach, suggest, nor disclose that an agreement with a “particular arena, promoter or entity” “*provid[es] for the [particular arena, promoter or entity] to receive a fee*,” as claim **31** recites. Specifically, as discussed above, Gebb discloses at column 7, line 53 to column 8, line 2 that the system “analyzes any agreements with the particular arena, promoter or entity regarding the establishment of [a] resale price.” “[I]f an agreement with a particular arena prevents” “the resale of tickets” “at a higher price” “than the face value of the ticket”, “the system will only add a transaction fee which conforms to any transaction fee limitation ... within an arena agreement” and “[i]f the ... arena does not restrict the resale of tickets at an increased price, ... buyers [are allowed] to ‘bid’ for the ticket such that the ticket will be sold to the highest bidder.” Again, Gebb discloses analyzing an agreement for a establishing a resale price but does not teach, suggest, nor disclose that an agreement with a “particular arena, promoter or entity” “*provid[es] for the [particular arena, promoter or entity] to receive a fee*,” as claim **31** recites.

In addition, Gebb in general does not teach, suggest, nor disclose the recited feature of claim **31**.

Because the Examiner has failed to show that all the limitations of dependent claim **31**, and similarly dependent claims **32-33**, **50-52**, **71-73**, **92-94**, and **113-115**, are taught or suggested by Gebb, the Examiner has failed to establish a *prima facie* case of obviousness with respect to these claims. The rejection is thereby improper.

7. Fifth Group: Claim 33, 52, 73, 94, and 115 - No Prima Facie Showing of Obviousness.

SEPARATE ARGUMENT OF PATENTABILITY.

The Fifth Group is a subset of the Third Group and the Fourth Group and is therefore patentable for the reasons set forth above for the Third Group and the Fourth Group. In addition, the following separate arguments of patentability apply.

Dependent claim **33** is representative of the group and recites, together with dependent claim **31**, the following features:

*providing for the provider to receive a fee from the payment from the second consumer; ...
wherein the fee is a percentage of the payment.*

Gebb does not teach, suggest, nor disclose “the fee is a percentage of the payment” and as such, the Examiner has failed to establish a *prima facie* case of obviousness with respect to the claims of the Fifth Group.

In particular, in rejecting claim **33**, the Examiner asserted without support that Gebb discloses at column 9, line 16 “the provider receives a fee from the payment of the second consumer, where the fee is ... a percentage payment.” Fourth Office Action, page 6. This portion of Gebb does not teach, suggest, nor disclose the above features of claim **33**.

Specifically, Gebb does not make any indication at this portion, nor any other portion, to a “fee [that] is a percentage of [a] payment,” let alone “providing for the provider to receive [such] a fee,” as discussed above with reference to claim **31**.

Because the Examiner has failed to show that the limitations of dependent claim **33**, and similarly dependent claims **52**, **73**, **94**, and **115**, are taught or suggested by Gebb, the Examiner has failed to establish a *prima facie* case of obviousness with respect to these claims. The rejection is thereby improper.

8. Sixth Group: Claims 12, 15, 36, 55, 76, 97, and 118 - No Prima Facie Showing of Obviousness.

SEPARATE ARGUMENT OF PATENTABILITY.

The Sixth Group is a subset of the Third Group and is therefore patentable for the reasons set forth above for the Third Group. In addition, the following separate arguments of patentability apply.

Dependent claim **15** is representative of the group and recites, together with independent claim **13**, the following features:

*receiving restrictions on the transfer of the item from the provider of the item; ...
wherein receiving restrictions on the transfer of the item comprises setting a minimum price for the item.*

Gebb does not teach, suggest, nor disclose “*wherein receiving restrictions on the transfer of the item comprises setting a minimum price for the item*” and as such, the Examiner has failed to establish a *prima facie* case of obviousness with respect to the claims of the Sixth Group.

In particular, in rejecting claim **15**, the Examiner asserted without support that Gebb discloses at column 7, line 53 “a restriction [that] comprises at least one of minimum transfer price.” Fourth Office Action, page 4. This portion of Gebb does not teach, suggest, nor disclose the above feature of claim **15**.

Specifically, at column 7, line 53 to column 8, line 2 Gebb discloses that the system “analyzes any agreements with the particular arena, promoter or entity regarding the establishment of [a] resale price.” “[I]f an agreement with a particular arena prevents” “the resale of tickets” “at a higher price” “than the face value of the ticket”, “the system will only add a transaction fee which conforms to any transaction fee limitation ... within an arena agreement” and “[i]f the ... arena does not restrict the resale of tickets at an increased price, ... buyers [are allowed] to ‘bid’ for the ticket such that the ticket will be sold to the highest bidder.” In establishing a resale price, as disclosed by Gebb at this portion, that includes the face value of the ticket plus a transaction fee or a resale price based on the highest bidder, Gebb at most discloses a maximum price restriction or no price restriction at all. As such, this portion of Gebb does not teach, suggest, nor disclose “*wherein receiving restrictions on the transfer of the item comprises setting a minimum price for the item*,” as claim **15** recites.

In addition, Gebb in general does not teach, suggest, nor disclose the recited feature of claim 15.

Because the Examiner has failed to show that all the limitations of dependent claim 15, and similarly dependent claims 12, 36, 55, 76, 97, and 118, are taught or suggested by Gebb, the Examiner has failed to establish a *prima facie* case of obviousness with respect to these claims. The rejection of these claims is thereby improper.

9. Seventh Group: Claims 12, 16, 37, 56, 77, 98, and 119 - No Prima Facie Showing of Obviousness.

SEPARATE ARGUMENT OF PATENTABILITY.

The Seventh Group is a subset of the Third Group and is therefore patentable for the reasons set forth above for the Third Group. In addition, the following separate arguments of patentability apply.

Dependent claim 16 is representative of the group and recites, together with independent claim 13, the following features:

*receiving restrictions on the transfer of the item from the provider of the item; ...
wherein receiving restrictions on the transfer of the item comprises setting a maximum number of items that may be sold.*

Gebb does not teach, suggest, nor disclose “*wherein receiving restrictions on the transfer of the item [from the provider of the item] comprises setting a maximum number of items that may be sold*” and as such, the Examiner has failed to establish a *prima facie* case of obviousness with respect to the claims of the Seventh Group.

In particular, in rejecting claim 16, the Examiner asserted without support that Gebb discloses at column 7, line 50 “placing additional restrictions on the item where the [re]striction comprises a maximum number of tickets available for sale.” Fourth Office Action, page 4. This portion of Gebb does not teach, suggest, nor disclose the above feature of claim 16.

Specifically, at column 7, lines 50-52 Gebb discloses that the “ticket server ... limits the number of tickets which an individual seller is allowed to consign per event.” While Gebb discloses at this portion that the “ticket server ... limits the number of tickets,” no where does Gebb appear to teach, suggest, or disclose that the “ticket server” is a “particular arena, promoter or entity” (i.e., “*provider*,” as asserted by the Examiner). As such, this portion of Gebb does not

teach, suggest, nor disclose “*wherein receiving restrictions on the transfer of the item [from the provider of the item] comprises setting a maximum number of items that may be sold,*” as claim **16** recites.

In addition, Gebb in general does not teach, suggest, nor disclose the recited feature of claim **16**.

Because the Examiner has failed to show that all the limitations of dependent claim **16**, and similarly dependent claims **12, 37, 56, 77, 98**, and **119**, are taught or suggested by Gebb, the Examiner has failed to establish a *prima facie* case of obviousness. The rejection is thereby improper.

IX. CONCLUSION

In view of the foregoing, Appellants submit that independent claims **1, 13, 34, 53, 74, 95,** and **116** and dependent claims **3-4, 6-12, 14-16, 20-22, 29-33, 35-37, 41, 48-52, 54-56, 60-62, 69-73, 75-77, 81-83, 90-94, 96-98, 102-104, 111-115, 117-119,** and **123-134** are in proper condition for allowance, and the Board is respectfully requested to overturn the Examiner's rejection of these claims.

Respectfully submitted,

/Glen R. Farbanish/

February 20, 2007

Date

Glen R. Farbanish

Reg. No. 50,561

Attorney for Appellants

X. CLAIMS APPENDIX

1. (Previously Presented) A method for enabling a first consumer to transfer an item with restricted transferability, comprising:

receiving a request to transfer the item from the first consumer;

presenting to the first consumer a plurality of options, wherein the options include a transfer by auction selection and a transfer by posting an advertisement selection, wherein posting an advertisement comprises posting a price;

requesting authorization to transfer the item from a provider of the item;

presenting information about the item to a second consumer in response to a selection by the first consumer of one of the options;

receiving from the second consumer an offer to purchase the item; and

transferring the item from the first consumer to the second consumer in response to receiving the offer to purchase.

Claim 2 (Cancelled).

3. (Original) The method defined in claim 1, further comprising:

contacting the provider to verify whether the first consumer possesses the item.

4. (Original) The method defined in claim 1, further comprising:

notifying the first consumer whether the provider authorized or denied the transfer.

Claim 5 (Cancelled).

6. (Original) The method defined in claim 1, further comprising:

voiding the item with respect to the first consumer; and

reissuing the item to the second consumer.

7. (Original) The method defined in claim 1, wherein transferring the item from the first consumer to the second consumer comprises:

providing the first consumer with an opportunity to send the item to an intermediary; and

providing the second consumer with an opportunity to send a payment to the intermediary.

8. (Previously Presented) The method defined in claim 7, further comprising charging at least one of the first consumer, the second consumer, and the provider with a fee.

9. (Original) The method defined in claim 8 wherein the fee is a flat fee.

10. (Original) The method defined in claim 1, wherein transferring the item from the first consumer to the second consumer comprises:

providing the first consumer with an opportunity directly to send the item to the second consumer; and

providing the second consumer with an opportunity directly to send a payment to the first consumer.

11. (Original) The method defined in claim 1, further comprising providing the provider with an opportunity to place additional restrictions on the item.

12. (Original) The method defined in claim 11 wherein the additional restrictions is at least one of a minimum transfer price, maximum number of items, and a contract extension.

13. (Previously Presented) A method for enabling a first consumer to transfer an item to a second consumer, the method comprising:

receiving a request to sell the item from the first consumer;

presenting to the first consumer a plurality of options, wherein the options include a transfer by auction selection and a transfer by posting an advertisement selection, wherein posting an advertisement comprises posting a price;

requesting authorization to transfer the item from a provider of the item;

receiving restrictions on the transfer of the item from the provider of the item;

implementing the restrictions with respect to the item;

presenting information about the item to the second consumer in response to a selection by the first consumer of one of the options;

receiving from the second consumer an offer to purchase the item; and

arranging for the transfer of the item from the first consumer to the second consumer in response to receiving the offer to purchase.

14. (Previously Presented) The method of claim 13 further comprising requesting authentication information from the first consumer prior to receiving a request to sell the item from the first consumer.

15. (Previously Presented) The method of claim 13 wherein receiving restrictions on the transfer of the item comprises setting a minimum price for the item.

16. (Previously Presented) The method of claim 13 wherein receiving restrictions on the transfer of the item comprises setting a maximum number of items that may be sold.

Claims 17-19 (Cancelled).

20. (Previously Presented) The method of claim 13 further comprising receiving a bid to purchase the item from the second consumer in response to presenting information about the item.

21. (Previously Presented) The method of claim 20 further comprising receiving acceptance of the bid by the first consumer.

22. (Previously Presented) The method of claim 13 further comprising requesting authentication information from the second consumer prior to arranging for the transfer of the item from the first consumer to the second consumer.

Claims 23-28 (Cancelled).

29. (Previously Presented) The method of claim 13 wherein arranging for the transfer of the item comprises:

instructing the first consumer to send the item to the second consumer; and
providing for the second consumer to make a payment for the item.

30. (Previously Presented) The method of claim 29 further comprising providing for the first consumer to receive at least part of the payment from the second consumer.

31. (Previously Presented) The method of claim 30 further comprising providing for the provider to receive a fee from the payment from the second consumer.

32. (Previously Presented) The method of claim 31 wherein the fee is a flat fee.

33. (Previously Presented) The method of claim 31 wherein the fee is a percentage of the payment.

34. (Previously Presented) A method for enabling a first consumer to transfer an item to a second consumer, the method comprising:

receiving a request to sell the item from the first consumer;

presenting to the first consumer a plurality of options, wherein the options include a transfer by auction selection and a transfer by posting an advertisement selection, wherein

posting an advertisement comprises posting a price;

requesting authorization to transfer the item from a provider of the item in response to receiving the request;

receiving restrictions on the transfer of the item from the provider of the item;

implementing the restrictions with respect to the item;

presenting information about the item to the second consumer in response to a selection by the first consumer of one of the options upon receiving authorization from the provider;

receiving a bid to purchase the item from the second consumer;

receiving acceptance of the bid by the first consumer; and

arranging for the transfer of the item from the first consumer to the second consumer.

35. (Previously Presented) The method of claim 34 further comprising requesting authentication information from the first consumer prior to receiving a request to sell the item from the first consumer.

36. (Previously Presented) The method of claim 34 wherein receiving restrictions on the transfer of the item comprises setting a minimum price for the item.

37. (Previously Presented) The method of claim 34 wherein receiving restrictions on the transfer of the item comprises setting a maximum number of items that may be sold.

Claims 38-40 (Cancelled).

41. (Previously Presented) The method of claim 34 further comprising requesting authentication information from the second consumer prior to arranging for the transfer of the item from the first consumer to the second consumer.

Claims 42-47 (Cancelled).

48. (Previously Presented) The method of claim 34 wherein arranging for the transfer of the item comprises:

instructing the first consumer to send the item to the second consumer; and
providing for the second consumer to make a payment for the item.

49. (Previously Presented) The method of claim 48 further comprising providing for the first consumer to receive at least part of the payment from the second consumer.

50. (Previously Presented) The method of claim 49 further comprising providing for the provider to receive a fee from the payment from the second consumer.

51. (Previously Presented) The method of claim 50 wherein the fee is a flat fee.

52. (Previously Presented) The method of claim 50 wherein the fee is a percentage of the payment.

53. (Previously Presented) A method for enabling a first consumer to transfer an item with restricted transferability to a second consumer, the method comprising:

receiving a request to sell the item from the first consumer;

presenting to the first consumer a plurality of options, wherein the options include a transfer by auction selection and a transfer by posting an advertisement selection, wherein posting an advertisement comprises posting a price;

contacting a provider of the item with respect to the transfer of the item;

receiving restrictions on the transfer of the item from the provider of the item;

implementing the restrictions with respect to the item;

presenting information about the item to the second consumer in response to a selection by the first consumer of one of the options;

receiving from the second consumer an offer to purchase the item;

and

arranging for the transfer of the item from the first consumer to the second consumer in response to receiving the offer to purchase.

54. (Previously Presented) The method of claim 53 further comprising requesting authentication information from the first consumer prior to receiving a request to sell the item from the first consumer.

55. (Previously Presented) The method of claim 53 wherein receiving restrictions on the transfer of the item comprises setting a minimum price for the item.

56. (Previously Presented) The method of claim 53 wherein receiving restrictions on the transfer of the item comprises setting a maximum number of items that may be sold.

Claims 57-59 (Cancelled).

60. (Previously Presented) The method of claim 53 further comprising receiving a bid to purchase the item from the second consumer in response to presenting information about the item.

61. (Previously Presented) The method of claim 60 further comprising receiving acceptance of the bid by the first consumer.

62. (Previously Presented) The method of claim 53 further comprising requesting authentication information from the second consumer prior to arranging for the transfer of the item from the first consumer to the second consumer.

Claims 63-68 (Cancelled).

69. (Previously Presented) The method of claim 53 wherein arranging for the transfer of the item comprises:

instructing the first consumer to send the item to the second consumer; and
providing for the second consumer to make a payment for the item.

70. (Previously Presented) The method of claim 69 further comprising providing for the first consumer to receive at least part of the payment from the second consumer.

71. (Previously Presented) The method of claim 70 further comprising providing for the provider to receive a fee from the payment from the second consumer.

72. (Previously Presented) The method of claim 71 wherein the fee is a flat fee.

73. (Previously Presented) The method of claim 71 wherein the fee is a percentage of the payment.

74. (Previously Presented) A method for enabling a first consumer to transfer a sporting event ticket to a second consumer, the method comprising:

receiving a request to sell the sporting event ticket from the first consumer;

presenting to the first consumer a plurality of options, wherein the options include a transfer by auction selection and a transfer by posting an advertisement selection, wherein posting an advertisement comprises posting a price;

contacting a provider of the sporting event ticket with respect to the transfer of the sporting event ticket;

receiving restrictions on the transfer of the sporting event ticket from the provider of the sporting event ticket;

implementing the restrictions with respect to the sporting event ticket;

presenting information about the sporting event ticket to the second consumer in response to a selection by the first consumer of one of the options;
receiving from the second consumer an offer to purchase the sporting event ticket;
and
arranging for the transfer of the sporting event ticket from the first consumer to the second consumer in response to receiving the offer to purchase.

75. (Previously Presented) The method of claim 74 further comprising requesting authentication information from the first consumer prior to receiving a request to sell the sporting event ticket from the first consumer.

76. (Previously Presented) The method of claim 74 wherein receiving restrictions on the transfer of the sporting event ticket comprises setting a minimum price for the sporting event ticket.

77. (Previously Presented) The method of claim 74 wherein receiving restrictions on the transfer of the sporting event ticket comprises setting a maximum number of sporting event tickets that may be sold.

Claims 78-80 (Cancelled).

81. (Previously Presented) The method of claim 74 further comprising receiving a bid to purchase the sporting event ticket from the second consumer in response to presenting information about the sporting event ticket.

82. (Previously Presented) The method of claim 81 further comprising receiving acceptance of the bid by the first consumer.

83. (Previously Presented) The method of claim 74 further comprising requesting authentication information from the second consumer prior to arranging for the transfer of the sporting event ticket from the first consumer to the second consumer.

Claims 84-89 (Cancelled).

90. (Previously Presented) The method of claim 74 wherein arranging for the transfer of the sporting event comprises:

instructing the first consumer to send the sporting event ticket to the second consumer; and

providing for the second consumer to make a payment for the sporting event ticket.

91. (Previously Presented) The method of claim 90 further comprising providing for the first consumer to receive at least part of the payment from the second consumer.

92. (Previously Presented) The method of claim 91 further comprising providing for the provider to receive a fee from the payment from the second consumer.

93. (Previously Presented) The method of claim 92 wherein the fee is a flat fee.

94. (Previously Presented) The method of claim 92 wherein the fee is a percentage of the payment.

95. (Previously Presented) A method for enabling a first consumer to transfer a concert ticket to a second consumer, the method comprising:

receiving a request to sell the concert ticket from the first consumer;

presenting to the first consumer a plurality of options, wherein the options include a transfer by auction selection and a transfer by posting an advertisement selection, wherein posting an advertisement comprises posting a price;

contacting a provider of the concert ticket with respect to the transfer of the concert ticket;

receiving restrictions on the transfer of the concert ticket from the provider of the concert ticket;

implementing the restrictions with respect to the concert ticket;

presenting information about the concert ticket the second consumer in response to a selection by the first consumer of one of the options;

receiving from the second consumer an offer to purchase the concert ticket; and

arranging for the transfer of the concert ticket from the first consumer to the second consumer in response to receiving the offer to purchase.

96. (Previously Presented) The method of claim 95 further comprising requesting authentication information from the first consumer prior to receiving a request to sell the concert ticket from the first consumer.

97. (Previously Presented) The method of claim 95 wherein receiving restrictions on the transfer of the concert ticket comprises setting a minimum price for the concert ticket.

98. (Previously Presented) The method of claim 95 wherein receiving restrictions on the transfer of the concert ticket comprises setting a maximum number of concert tickets that may be sold.

Claims 99-101 (Cancelled).

102. (Previously Presented) The method of claim 95 further comprising receiving a bid to purchase the concert ticket from the second consumer in response to presenting information about the concert ticket.

103. (Previously Presented) The method of claim 102 further comprising receiving acceptance of the bid by the first consumer.

104. (Previously Presented) The method of claim 95 further comprising requesting authentication information from the second consumer prior to arranging for the transfer of the concert ticket from the first consumer to the second consumer.

Claims 105-110 (Cancelled).

111. (Previously Presented) The method of claim 95 wherein arranging for the transfer of the concert ticket comprises:

instructing the first consumer to send the concert ticket to the second consumer;

and

providing for the second consumer to make a payment for the concert ticket.

112. (Previously Presented) The method of claim 111 further comprising providing for the first consumer to receive at least part of the payment from the second consumer.

113. (Previously Presented) The method of claim 112 further comprising providing for the provider to receive a fee from the payment from the second consumer.

114. (Previously Presented) The method of claim 113 wherein the fee is a flat fee.

115. (Previously Presented) The method of claim 113 wherein the fee is a percentage of the payment.

116. (Previously Presented) An electronic trading arrangement for enabling a first consumer to transfer an item to a second consumer, the arrangement comprising:

a provider system;

a transfer system;

a first consumer computer;

at least one second consumer computer; and

a communication network that interlinks the provider system, the transfer system, the first consumer computer, and the at least one second consumer computer, wherein the transfer system is configured:

(a) to receive data from the first consumer computer relating to a request to transfer the item,

(b) to present to the first consumer a plurality of options, wherein the options include a transfer by auction selection and a transfer by posting an advertisement selection, wherein posting an advertisement comprises posting a price,

(c) to transmit data to the provider system requesting authorization to transfer the item based on receipt of the request data,

(d) to receive data from the provider system relating to restrictions placed on the transfer of the item;

(e) to implement the restrictions with respect to the item;

(f) to present data relating to information about the item to the second consumer computer in response to a selection by the first consumer of one of the options,

(g) to receive from the second consumer an offer to purchase the item,
and
(h) to arrange for the transfer of the item from the first consumer to the second consumer in response to receiving the offer to purchase.

117. (Previously Presented) The electronic trading arrangement of claim 116 wherein the transfer system comprises a database to store information received from the first consumer computer, the at least one second consumer computer, and the provider system.

118. (Previously Presented) The electronic trading arrangement of claim 116 wherein the transfer system is configured to receive restrictions that set a minimum price for the item.

119. (Previously Presented) The electronic trading arrangement of claim 116 wherein the transfer system is configured to receive restrictions that set a maximum number of items that may be sold.

Claims 120-122 (Cancelled).

123. (Previously Presented) The electronic trading arrangement of claim 116 wherein the transfer system is further configured to receive data from the second consumer indicating a bid to purchase the item.

124. (Previously Presented) The electronic trading arrangement of claim 123 wherein the transfer system is further configured to receive data from the first consumer indicating acceptance of the bid to purchase the item from the second consumer.

125. (Previously Presented) The electronic trading arrangement of claim 116 wherein the transfer system comprises an internet web page server.

126. (Previously Presented) The electronic trading arrangement of claim 116 wherein the transfer system, the first consumer computer, and the at least one second consumer computer form part of a single server.

127. (Previously Presented) The electronic trading arrangement of claim 116 wherein the transfer system, the first consumer computer, and the at least one second consumer computer are distributed across multiple servers.

128. (Previously Presented) The electronic trading arrangement of claim 116 wherein the communication network comprises one of an Internet, an intranet, a public data network, a private data network, a wireless network, a cable network, and a dial-up connection.

129. (Previously Presented) The electronic trading arrangement of claim 116 wherein the transfer system is configured to receive transfer criterion that sets at least one of a sale price and a sale duration.

130. (Previously Presented) The method defined in claim 1 wherein a transfer criterion comprises at least one of a sale price and a sale duration.

131. (Previously Presented) The method defined in claim 13 wherein a transfer criterion comprises at least one of a sale price and a sale duration.

132. (Previously Presented) The method defined in claim 53 wherein a transfer criterion comprises at least one of a sale price and a sale duration.

133. (Previously Presented) The method defined in claim 74 wherein a transfer criterion comprises at least one of a sale price and a sale duration.

134. (Previously Presented) The method defined in claim 95 wherein a transfer criterion comprises at least one of a sale price and a sale duration.

Claim 135 (Cancelled).

XI. EVIDENCE APPENDIX

None

XII. RELATED PROCEEDINGS APPENDIX

None